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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* SHINOBU TANAKA

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Appeal 2009-005644
Application 10/695,817
Technology Center 2800

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Before ROBERT E. NAPPI, JOHN C. MARTIN, and JOSEPH F. RUGGIERO, *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 1 through 13 and 15 through 17.

We affirm-in-part and enter a new rejection.

## INVENTION

The invention is directed to an apparatus for preventing an unqualified person from driving a vehicle. See page 2 of Appellant's Specification. Claim 1 is reproduced below:

> 1. An apparatus for preventing an unqualified person from driving a vehicle, comprising:
>
> a marker detector provided in the vehicle to detect a qualified person marker held by a driver having a driving qualification appropriate for driving the vehicle only when the driver holds the qualified person marker opposite the marker detector; and
>
> a control unit for continuously monitoring an output from the marker detector and taking a predetermined measure to ensure safety when a state occurs in which the qualified person marker is not detected,
>
> wherein the predetermined measure is released when the marker detector again detects the qualified person marker.

## REFERENCES

| | | |
|---|---|---|
| Kito | JP 10-82223 | Mar. 31, 1998 |
| Thorpe | GB 2395331 A | May 19, 2004 |

REJECTIONS AT ISSUE

The Examiner has rejected claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 102(b) as being anticipated by Kito. Answer 3-7.[2]

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Kito in view of Thorpe. Answer 7-8.

ISSUES

*Rejection of claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 102(b)*

Appellant argues on pages 9 through 12 of the Appeal Brief[3] that the Examiner's rejection under 35 U.S.C. § 102(b) based upon Kito is in error.

Appellant's arguments present us with the following issue: did the Examiner err in finding that Kito teaches that the predetermined measure is released when the marker detector again detects the qualified person marker as recited in claims 1 and 8?

*Rejection of claim 7 under 35 U.S.C. § 103(a)*

Appellant argues on page 13 of the Appeal Brief that the Examiner's rejection under 35 U.S.C. § 103(a) based upon Kito in view of Thorpe is in error.

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[2] Throughout this opinion we refer to the Examiner's Answer dated August 13, 2008.

[3] Throughout the opinion, we refer to the Appeal Brief filed May 15, 2008, and Reply Brief filed October 10, 2008.

Appellant's arguments present us with the following issue: do the additional teachings of Thorpe compensate for the deficiencies in the rejection of claim 1?

## FINDINGS OF FACT

1. Kito teaches a vehicle theft prevention system where a user has a transponder within their shoe which is read by a receiver in the vehicle. Paras 0017-0018 of translation.
2. In Kito's system after the ignition system is turned on, the engine has exceeded 2K rpm, and a predetermined time has elapsed, the transponder is read. If a valid transponder is not identified, the system immobilizes the vehicle. Fig. 4, paras. 0024-0029 of translation.
3. Kito is silent as to how the vehicle can be started after the system has immobilized the vehicle.
4. Thorpe teaches a control system for a vehicle where users of the vehicle carry tags read by a transceiver in the vehicle. Abstract.
5. Thorpe's system also includes a security system which immobilizes the vehicle via an ignition lock. The lock is automatically activated when the driver is away from the driver compartment and disabled upon the driver's return. Pg. 12, ll. 16-17.

ANALYSIS

*Rejection of claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 102(b)*

At the outset we note that we will not sustain the Examiner's rejection of claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 102(b) because as discussed *infra* we find that the Examiner's reasoning supports an obviousness rejection and not an anticipation rejection.

In rejecting claim 1 the Examiner finds that Kita anticipates every limitation in the claim. Answer 3-4. With respect to the limitation directed to the predetermined measure being released when the marker detector again detects the qualified person marker, the Examiner states "one of ordinary would have envisioned providing access to the vehicle when the authorized person holding the transponder 11 gets in the car after it has stopped, to operate the car once it has been recovered from a theft attempt, for example." Answer 4. Additionally, the Examiner interprets claim as to "not require that the predetermined measure be released at the time of the marker detector again detecting the qualified person marker." Answer 9.

We disagree with the Examiner's claim interpretation. As argued by Appellant on page 6 of the Reply Brief, the limitation "is released when ..." recites a contemporaneous action, thus the releasing occurs when the detector detects a person. Thus, we consider the Examiner's interpretation of claim 1 to be unreasonable.

However, we agree with the Examiner that a person of ordinary skill would have envisioned that Kato's device can be designed to release the immobilizer (the claimed predetermined measure) when the authorized transponder is again sensed (the claimed marker detector detecting the

qualified person marker). Note that the disclosure of Thorpe supports this finding. Fact 5. However, this rationale does not support an anticipation rejection but rather an obviousness rejection. Accordingly, we will not sustain the Examiner's rejection under 35 U.S.C. § 102(b), but enter a new rejection of claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 103(a) applying the Examiner's rationale and the teachings of Thorpe. Specifically, we adopt the Examiner's findings regarding Kito's teachings of a marker detector and control unit. Facts 1-3. We find that Thorpe teaches a security system where the vehicle is disabled (ignition locked) when the authorized user with a transponder is not sensed in the vehicle and the vehicle is enabled upon return of the transponder. Fact 5. We adopt the Examiner's conclusion that the skilled artisan would have recognized that Kito's system can be modified to allow a user to disable the immobilizer with the authorized transponder when the user returns it to the vehicle, for the purpose of allowing the user to operate the vehicle after it is recovered.

*Rejection of claim 7 under 35 U.S.C. § 103(a)*

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 7. Appellant argues, on page 13 of the Brief, that Thorpe does not make up for the deficiencies noted in the rejection of claim 1. As discussed above with respect to claim 1, we concur that the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) is in error, but we have entered a new rejection under 35 U.S.C. § 103(a) based upon the teachings of Kato and Thorpe. Thus, as discussed above, we find that the

additional teachings of Thorpe make up for the noted deficiency in the rejection of claim 1 and we sustain the Examiner's rejection of claim 7.

## SUMMARY

We will not sustain the Examiner's rejection of claims 1 through 6, 8 through 13, and 15 through 17 under 35 U.S.C. § 102(b). However, we sustain the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a). We enter a new rejection against claims 1 through 6, 8 through 13 and 15 through 17 under 35 U.S.C. § 103(a).

## ORDER

The decision of the Examiner to reject claims 1 through 13 and 15 through 17 is affirmed-in-part.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). This section provides that "[a] new ground of rejection... shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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